

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1, 3 and 5-16 are now pending in this application. New claims 15 and 16 have been added. Claim 15 recites a specific location for the prism pattern. Claim 16 further limits claim 15 by inserting the limitations of claim 3, 8 and 9. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE OBJECTIONS TO THE CLAIMS HAVE BEEN OVERCOME

The applicants did not understand the basis for the objection for omitting essential structural cooperative relationship of elements as the claim appears to be in proper format and was not otherwise rejected on 112, first or second paragraph grounds. MPEP 2111 states that claims are to be given their broadest reasonable interpretation and it is unclear why this was not possible. Claim 15 recites a specific location for the prism pattern, but this was not necessary for consideration of claim 1.

II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

1. **Claims 1, 5, 6, 8, 9, 11 and 12** were rejected as allegedly being obvious by Jeon (6,729,737) in view of Harada (JP 2003-202415) and further in view of Funamoto (JP 11-250714). The applicants request reconsideration of this rejection for the following reasons cited in the previous response.
2. **Claims 2-4 and 14** were rejected as allegedly being obvious over Jeon, Harada, Funamoto (*ibid.*) and Shigematsu (JP 2003-075611).
3. **Claims 7, 10 and 13** were rejected as being allegedly obvious over Jeon, Harada, Funamoto (*ibid.*) and Karanaru (JP 2003-121656)

As each of the rejections use the combination of Jeon, Harada and Funamoto, the applicants previous response to the this rejection should be considered repeated here. The applicants also add that while there is no limit on the number of applications which can be used for an obviousness rejection, it also noted that considerations of obviousness is not merely a collection of elements from available references.

As stated in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998):

“As this court has stated, ‘virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’ *Sensotronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).” *Rouffet*, 149 F.3d at 1357, 47 USPQ2d 1457.

The applicants invention is not the individual elements in isolation, but simultaneous combination of these elements to form the surface light source device of the invention. While an obvious to try rationale may be appropriate if there is only a finite number of identified, predictable solutions with a reasonable expectation of success, this does not hold true for the combination of Jeon, Harada, Funamoto, i.e. the number of elements which could be selected from the combination of Jeon, Harada and Funamoto is far greater than the total number of elements in the applicants claimed invention and the potential number of solutions from the combination of Jeon, Harada and Funamoto is not finite in number.

While the Examiner has a copy of the applicants claims before her, the person of ordinary skill in the art does not have this answer key before them which would assist in limiting this virtually infinite number of potential combinations.

The rejections which further rely on the teachings of Shigematsu and Karanaru only exacerbate the “finite number” of solutions problem and is even further removed as valid assertions of prima facie obviousness based on Jeon, Harada and Funamoto.

For these reasons, claims 1-14 are unobvious over the prior art. (New claims 15 and 16 are also believed to be unobvious over this prior art rejection)

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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